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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,653	07/23/1999	JOHN M. HILLMAN	CITI0092-US	1816

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EXAMINER

KYLE, CHARLES R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/358,653

Applicant(s)

HILLMAN ET AL.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-6, 9-12 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-6, 9-12 and 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Based on the cancellation of Claims 1 and 2, their rejection is withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shurling et al.

**Regarding Claim 12**, Shurling et al disclose the invention substantially as claimed including in a method for leveraging a financial relationship between a customer of a financial institution and a financial institution (Summary of the Invention), the steps of:

establishing a financial account at the financial institution for the benefit of the customer (Col. 5-27) ;

adding value to financial accounts at predetermined intervals, wherein the value is comprised of immediate access value (Col. 3, lines 12-26) and vested access value (Col. 15, lines 9-24; Col. 11, line 46 to Col. 12, line 35), and further wherein the immediate access value is added to the first financial account by the customer in an amount determined by the customer and at the direction of the customer (Col. 3, lines 12-26);

calculating the vested access value by

(a) determining a number of individual components comprising the financial relationship (Col. 11, lines 11-30),

(b) calculating an individual value for each of the individual components at the end of a set period of time (Col. 10, line 65 to Col. 12, line 56),

(c) multiplying the determined individual value of each of the individual components by a pre-selected percentage to obtain a vested access value (Col. 11, line 58 to Col. 12, line 8, particularly Col. 11, lines 64-66); and

(d) adding the vested access value to the financial account (Col. 13, line 62 to Col. 14, line 3), wherein the immediate access value is retrievable by the customer from the financial account without restriction (Col. 3, lines 12-26), but the vested access value is only retrievable by the customer after a predetermined period of time (Col. 1, line 55 to Col. 2, line 5).

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As noted above, Shurling discloses a program where immediately accessible, depositor controlled accounts are established as are incentive award accounts where vesting must occur to realize benefit of the awards. Shurling does not specifically disclose that immediate access and vested value amounts are held in a single account.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have held such amounts in a single account, both for ease of record keeping and to remind the customer that as well as his principal value, award values were accruing which would be available if he or she were loyal to the institution. It would be useful to remind the customer of award value (e.g. waived checking account fees awarded monthly) at the same time that the customer reviewed a periodic report of an account (e.g. a checking account statement). This reasoning is specifically set forth by Shurling at Col. 1. line 30 to Col. 2, line 43.

C3/L22-24

C15/L47- C16/L31

**Claims 3-6, 9-11 and 16-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shurling et al in view of Ferguson et al.

**Regarding Claim 3**, Shurling et al disclose the invention substantially as claimed including in a method for leveraging a financial relationship between a customer of a financial institution and a financial institution (Summary of the Invention), the steps of:

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a) collecting financial relationship information separately from each of the customer (Col. 4, lines 51-56) and the financial institution (Col. 4, lines 34-39);

b) evaluating the financial relationships between the customer and the financial institution based on the financial relationship information (Col. 2, line 63 to Col. 3, line 11);

c) awarding a total value to the customer based on the evaluation of the financial relationships (Col. 2, lines 46-62);

Shurling does not specifically include inclusion of a third party and its relationships or the details of holding, transferring and redeeming a total value award.

Ferguson discloses relationships between a customer and a third party (Col. 6, lines 16-22) and collecting information from the third party and evaluation of relationship with the third party (Col. 6, lines 33-48).

Ferguson further discloses:

d) holding the total value award in a first financial account located at the financial institution (Col. 7, lines 8-62; Fig. 1, element 26);

e) selecting a second financial account located at the financial institution into which the total value award is transferred upon expiration of the predetermined period of time (Fig. 1, element 30); and

f) redeeming the total value award into the second financial account upon expiration of the predetermined period of time (Fig. 1, element 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the customer-third party relationship and information in the awarding of value of Ferguson in the method of Shurling because this would have encouraged customers to complete transactions with a third party (Ferguson, Col. 1, lines 48-64, while providing a centralized and simple method of evaluating relationship activity (Shurling, Summary of the Invention).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the option of transferring award amounts in the fashion described in Ferguson et al in the financial leveraging system disclosed by Shurling et al because this would have provide a consolidated account for distribution of awards and would have facilitated tracking and auditing of accounts to which awards were made. It would further have been obvious to have utilized a predetermined delay for funds transfer in cases in which a minimum balance was required to open an account or "open season" timing concerns existed for account opening. Additionally, Shurling et al specifically disclose concerns with vesting of award amounts, which would entail predetermined periods for award grant.

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**As to Claim 16**, Ferguson et al disclose the first financial account as a pooled account at Col. 10, lines 25-40. This pooled account is read as the equivalent of a saving account in that it "saves" award amounts for later distribution to customers.

**As to Claim 17**, Ferguson et al disclose the second financial account as a brokerage account at Col. 11, lines 23-35 and Fig. 1, ele. 30.

**Concerning Claim 18**, Ferguson et al disclose the brokerage account as a mutual fund at Col. 11, lines 29-31.

**With respect to Claim 19**, Ferguson et al disclose loan accounts, investment accounts and service accounts at Col. 1, lines 6-27.

**With respect to Claim 20**, Ferguson et al disclose a loan account as a mortgage at Col. 1, line 19.

**With respect to Claim 21**, Ferguson et al disclose an investment account as a CD at Col. 1, lines 19-20.

**With respect to Claim 22**, Ferguson et al disclose a service account as an insurance account at Col. 1, line 20.

**Regarding Claims 4-5**, see the discussion of Claim 12 above.

**Regarding Claim 6**, Shurling discloses a customer relationships with credit card and insurance providers at Col. 1, lines 5-27. It would have been obvious to have allowed third parties to provide such service relationships because this would have increased market share for the program.

**With respect to Claims 9-11**, see the discussion of Claims 16-18 set forth above.



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### ***Response to Arguments***

Applicant's arguments with respect to claims 3 and 12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure..

US 6,243,688 B1                      Kalina

US 5,745,706 A                      Wolberg et al

US 6,026,382 A                      Kalthoff

“Discover Card Features ...Cashback Bonus Award “ Web archive document

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

crk

crk

May 17, 2002

VINCENT MILLIN  
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